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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,250	04/27/2001	William Armstrong Rooke	GRIHAC P35AUS	8932

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EXAMINER	
NGUYEN, TAN D	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 03/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/844,250	ROOKE, WILLIAM ARMSTRONG	
	Examiner	Art Unit	
	Tan Dean D. Nguyen	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 April 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because it contains 2 paragraphs. Correction is required. See MPEP § 608.01(b).

2. The disclosure is objected to because of the following informalities: pages 7-10, vertical lines in the middle of the page. Page 8, line 3, underlining phrase "attribute data"? It's not clear why is it underlined? Page 12, line 2 "(e.g. - see later) is vague and indefinite.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Method claims 1-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory classes of invention as set forth in § 101 (i.e. a process, machine, manufacture, or composition of matter).

In the present case, claims 1-21 are directed to "A method of obtaining knowledge about an enterprises data", which is not within one of the classes of invention set forth in § 101.

The "A method of obtaining knowledge about an enterprises data" comprising the steps of:

(a) analyzing business intelligence artifacts produced by users of an enterprises business intelligence system,

(b) producing metadata based on the analysis, and

(c) making the metadata available for access by users to query to provide information about the enterprise data", as shown are merely an abstract idea and do not produce a useful, tangible, concrete results.

The "method of obtaining knowledge about an enterprises data" comprising the steps of (a)-(c) as shown are:

1) merely an abstract idea and

2) does not reduce to a practical application in the technological arts (integration with computer/ computer network to produce an output result) and are therefore are found to be non-statutory. See *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557, or *In re Waldbaum*, 173 USPQ 430 (CCPA 1972) or *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172

Claim Rejections - 35 USC § 112

5. **Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling.** From the specification, page 10, lines 25-28, "A query means 25 enables users 2 to have access to the stored metadata to provide knowledge of actual use of BI data artifacts are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Claims 1-12 fail to include a

positive recitation of the step of querying the metadata to provide information about the enterprises data.

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It's not clear whether the "users" on line 3 and 6 are the same or different.

7. **Claims 22-41 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling.** From the specification, page 10, lines 25-28, "A query means 25 enables users 2 to have access to the stored metadata to provide knowledge of actual use of BI data artifacts are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Claims 22-41 fail to include a query means 25 enables users 2 to have access to the stored metadata to provide knowledge of actual use of BI data artifacts are critical or essential to the practice of the invention which is a system for obtaining knowledge about an enterprise's data.

8. Claims 22 recites the limitation "the analysis" in line 5. There is insufficient antecedent basis for this limitation in the claim. Also, claim 22 is vague and indefinite because it calls for a system for obtaining knowledge about an enterprise's data but there is no discussion of "obtaining knowledge" in the body of the claim. The last step "producing metadata" is noted, but there is no discussion with respect to "obtaining knowledge about an enterprise's data.

9. Claims 33 recites the limitation "the business item data" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 22-40 are rejected under 35 U.S.C. 102(a) as being anticipated by HODGES et al (Article "The National Library ...Initiatives").

As for independent apparatus claim 22, HODGES et al discloses a system for obtaining knowledge about data, comprising:

a harvester means (harvesting) for analyzing data/facts and providing metadata {see page 11, 1st full paragraph, page 4, last paragraph}. Also, in apparatus claim, features of an apparatus must be cited structurally or functionally (means plus function) or what a device is, not what a device does. The type of data, or data about data (artifacts) have no patentable weight. Also, the source of data, produced by users of an enterprise's business intelligent system, has no patentable weight.

As for dep. claim 23 (part of 22), the phrase "is arranged to analyze" has no patentable weight for the same reason set forth above. Patentability of the apparatus is what a device is, not what it does. Moreover, the use of attributes of data for analysis is taught in page 13, paragraphs 2 and 3.

As for dep. claim 24 (part of 22), which deals with the list of attributes, this is also taught in page 13, 2nd paragraph.

As for dep. claim 25 (part of 22), the phrase "is arranged to produce" has no patentable weight for the same reason set forth above. Patentability of the apparatus is what a device is, not what it does. Moreover, this is inherently included when carrying out the teaching of HODGES et al above.

As for dep. claims 26-33 (part of 22), which deals with the characteristics of the tribute data or type of data, these carry no patentable weight in an apparatus claim as indicated above.

As for dep. claims 34-40 (part of 22), which deals with a query means and its querying parameters, such as matching means, determination means, and identification means, etc., they are inherently in the teachings of HODGES et al as mere well known parameters of search engines which are capable of harvesting the data and making it available {see page 11, 1st full paragraph}.

14. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over HODGES et al.

The teaching of HODGES et al is cited above. As for dep. claim 41, which deals with well known data documentation parameter, i.e. annotation means, for selectively annotating or placing a remark on the harvesting data, this is well known and would have been obvious if desired.

15. **Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA (applicant admitted prior art) in view of HODGES et al.**

As for independent method claim 1, AAPA as shown in the specification pages under "Background of the Invention", fairly teaches a method of obtaining knowledge about an enterprises data, comprising the steps of (a) obtaining business intelligent artifacts produced by users of an enterprises business intelligence system. However, as shown on page 2, the problems with these artefacts, or user's knowledge, are that they are not readily accessible or users have no proper access to this knowledge or artefacts or data.

Hodges, as cited above, fairly teaches a method for (a) analyzing general information or data from documents or reports or publications, (b) producing the meta

based on the analysis, and (c) making the metadata available for access by users to query to provide information about the data {see page 1, abstract, introduction, page 4, last paragraph, page 11, 1st full paragraph}. It would have been obvious to modify the teaching of AAPA by carrying out steps (a)–(c) as taught by HODGES et al to make all document/publication/ information resources data available for accessing by any users, thus overcoming the problems mentioned in AAPA above. {see page 1, abstract, and introduction or page 11, 1st and 2nd paragraphs}.

As for dep. claims 2-7 (part of 1) which deals with well known harvesting parameters, i.e. based on various attributes of data or artifacts, these are fairly taught in HODGES et al page 13, 1st paragraph to 4th paragraph and would have been obvious to an artisan modify the teachings of AAPA/HODGES et al to apply to conditions of AAPA.

As for dep. claims 8-12 (part of 1) which deals with well known harvesting parameters, i.e. based on various attributes of data or artifacts, these are fairly taught in HODGES et al page 13, 1st paragraph to 4th paragraph and would have been obvious to an artisan modify the teachings of AAPA/HODGES et al to apply to conditions of AAPA.

As for dep. claims 13-19 (part of 1), which deals with a query issue and its querying parameters, such as matching data, determination step, and identification step, etc., they are inherently in the teachings of HODGES et al as mere well known parameters of search engines which are capable of harvesting the data and making it available for accessing {see page 11, 1st full paragraph}. The application of the querying mechanism of HODGES et al to meet the desired problem of AAPA, making BI

artifacts available and known, would have been obvious as mere implementing the teachings of HODGES et al on AAPA.

As for dep. claim 20 (part of 1), which deals with well known data documentation parameter, i.e. annotation means, for selectively annotating or placing a remark on the harvesting data, this is well known and would have been obvious if desired.

As for dep. claim 21 (part of 1) which deals with well known data or artefact parameters, i.e. analytical document or presentation, these are fairly taught in HODGES et al page 1, 1nd and 2nd paragraphs "library documents", page 4, last paragraph, page 11, 1st paragraph to 2th paragraph. Moreover, it would have been obvious to an artisan modify the teachings of AAPA/HODGES et al to apply to conditions of AAPA.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

I. US Patent:

(1) US 6,377,993 discloses the use of harvesting for extract and harvest metadata from datamarts {see Fig. 8, col. 19}.

II. NPL:

(1) Article "Architecture and software solutions" by Gardner, teaches method and system for harvesting metadata {see page 2}.

(2) Article "Metadata: projects & standard" by Milstead, teaches tools for creation, harvesting, and indexing core-based metadata {see page 5}.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see http://pair-direct@uspto.gov. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov .

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053 or (571) 272-6806 (by April 15, 2005). My work schedule is normally Monday through Friday from 7:00 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. My personal Fax is (703) 872-9674. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
March 9, 2005

DEAN T. NGUYEN
PRIMARY EXAMINER